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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,035	02/27/2002	Robert Kincaid	1001011076-1	6480

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EXAMINER
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SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

NOTIFICATION DATE	DELIVERY MODE
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12/01/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/087,035	<b>Applicant(s)</b> KINCAID, ROBERT	
	<b>Examiner</b> Carolyn Smith	<b>Art Unit</b> 1631	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-11,22,27,28,31-37,41-44 and 47-49.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

11/21/08

/Carolyn Smith/  
 Primary Examiner, Art Unit 1631

Continuation of 3. NOTE: The proposed claim set presents additional claims without cancelling a corresponding number of finally rejected claims. Also, the proposed claim set recites new limitations, such as "obtaining raw sequence data from a search" and using a first and second computer which raise new issues that would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: the proposed claim set raises and issues and presents additional claims without cancelling a corresponding number of finally rejected claims. Because the proposed amendment will not be entered, the 35 USC 103 rejection in the previous final office action, mailed 8/28/08, is maintained.

Applicant argues that the Examiner indicated that copies of the provisionals could not be readily obtained when the Office action was mailed so that the Examiner has no way of knowing whether the provisional applications in fact, support the priority dates relied upon. This statement is found unpersuasive as Examiner has access to a computer image of the provisionals. Also, it is noted that Applicant mailed copies of the provisionals (60/301298 and 60/265103) to the USPTO on 2/28/07. Applicant argues that the Examiner needs to provide evidence upon which the obviousness ground of rejection is based and it is improper to attempt to shift the burden of providing evidence to Applicant. This statement is found unpersuasive as the Examiner has provided sufficient evidence of the obviousness ground of rejection.

### 35 USC 103 rejection

Applicant reiterates arguments regarding the provisional applications which have already been found unpersuasive above. It is reiterated that the Examiner has access to computer images of the provisionals. Applicant summarizes part of the 35 USC 103 rejection, argues that instant claims do not recite a user selecting probe set identifiers from a corresponding list that corresponds to a gene", but rather recite at least one gene of interest, having been selected by a customer, that is received from a customer. This statement is found unpersuasive as Zhou et al. describe a web portal processes inquiries regarding biological information for microarray experiments and a user selects « probe set identifiers » which enable detection of nucleic acids and corresponding genes which are identified (paragraphs 0005, 0009), as user requesting a corresponding probe set for a specified gene sequence (0093), and receiving one or more genes from a user as well as user notations (0168 and 0169) which represents receiving from a customer, at least one array design parameter and notification of at least one gene of interest. Indeed, Zhou et al. specifically states in paragraph 0169 that the method receives gene information from a user. Applicant argues that a gene is selected which is found unpersuasive as the instant claim 1 recites "receiving [...] notification of at least one gene" which has been interpreted broadly and reasonably as described above. Applicant argues that none of the information from Zhou et al.'s paragraphs 0093, 0168, and 0169 are in provisional application 60/301,298. This statement is found unpersuasive as 60/301298 describes custom design based on sequences provided by a customer (page 2) and a requestor completing a FCA (flexible content array design) (page 5). In addition, Markowitz et al. describe using custom gene sequences (0037), user selection and user-selected gene attributes (parameters) (0110, 0229) allowing users to specify parameters and adjust parameters (0050), sequence searching for a user-provided nucleotide sequence against a database of GenBank sequences corresponding to Affymetrix (vendor) probe sets (0249), and sequence based matching and manual data curation including detecting potential sequence data contamination (0043, 0046). Cracauer et al. describe a high-throughput oligonucleotide production system (claim 1), designing and producing detection assays for target sequences (0434), and receiving orders from a customer who enters a target sequence into a web interface, processing orders, and designing the detection assays which can be produced and shipped to customers (0435, 0539). Applicant summarizes Zhou et al.'s paragraphs 0095, 0096, 0124, 0110, 0112, 0116, 0119, 0122 and argues these passages do not describe accessing/searching a database to obtain data for probe selection for at least one gene of interest such that correspondence may be provided to the user. This statement is found unpersuasive as Zhou et al. describe these limitations given their broad and reasonable interpretations. Zhou et al. describe gene accession numbers with correspondence between probe sets and genes maintained in a database and obtaining genomic data related to a selected accession number which is provided to a user (0095). In addition, Zhou et al. describe accessing databases to provide researchers with associations between probe sets and gene identifiers, using Entrez search and retrieval system that provides information from various NCBI databases including nucleotide sequences, including accessing NCBI Entrez nucleotide database, and associations of a gene or probe-set identifier to products and a genomics database (0075, 0076, 0084, 0033, 0027, 0028, 0034), a user requesting a corresponding probe set for a specified gene sequence, and a database with the sequence or sequences from which the probes are designed (0093), and accessing/searching a database to obtain sequence data for probe selection for at least one gene of interest such that the correspondence may be provided to the user (0095, 0096, 0124, 0110, 0112, 0116, 0119, 0122), searching database for user provided sequence to verify existence of one or more corresponding probe sets and correlating identity of probe sets having a corresponding sequence with probe set identifiers (0124), or analyzing user provided input sequence to determine which portions should be represented by probes (0125), and databases including information relating probe set identifiers to probe sequences (0114) which represents database searching to obtain sequence data for probe selection for at least one gene of interest. Applicant argues the accessing/searching a database is not present in provisional 60/301298. This statement is found unpersuasive as 60/301298 recites various databases (pages 2 and 3), sequence blasting (Section 2.3.3), and search query (page 8, last paragraph). Applicant argues that Zhou et al. teaches away from modifications because provisional application 60/301298 discloses the system does not include sequence blasting capabilities in section 2.3.2. This statement is found unpersuasive as the next section 2.3.3 states the Portal system will provide sequence blasting capabilities. Applicant argues that Markowitz et al. has nothing to do with design or fabrication of arrays. This statement is found unpersuasive as Markowitz et al. is not relied on these limitations for the 35 USC 103 rejection. Applicant is reminded that all limitations in a 35 USC 103 rejection do not need to come from a single reference. Applicant argues that has to be a reason to combine references. It is noted that motivational statements have been provided. Applicant reiterates certain arguments that have already been found unpersuasive. Applicant summarizes Cracauer et al. and argues it is not prior art. This statement is found unpersuasive since it describes at least one of the rejected limitations. Applicant reiterates arguments that have already been found unpersuasive. New claims are not considered as the amendment has not been entered.

It is noted that the declaration filed by Applicant on 1/21/05 states the invention was conceived prior to July 16, 2001. Zhou et al.'s provisional 60/301298 was filed June 25, 2001. The Examiner wonders if Applicant can and is willing to swear behind the date of 60/301298 (which is less than a month earlier than what has already been sworn behind).

